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In re Application of  
Hans-Michael Eggenweiler et al  
Serial No.: 10/750,878  
Filed: January 5, 2004  
Attorney Docket No.: MERCK-2412-D01

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: PETITION DECISION  
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This is in response to the petition under 37 CFR 1.144, filed September 12, 2006, requesting withdrawal of an improper restriction requirement.

#### BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on January 5, 2004, and contained claims 5-8, following preliminary amendment. In a first Office action, mailed March 28, 2005, the examiner required an election of species prior to examination.

Applicants replied on April 28, 2005, electing a specific compound and a specific condition for the method of treatment, with traverse.

The examiner mailed a new Office action to applicants on July 14, 2005, acknowledging the species elected, responding to the traverse and making the requirement Final. The examiner then rejected claims 5-8 under 35 U.S.C. 112, first paragraph, for lack of enablement from three different perspectives, and under second paragraph for indefiniteness.

Applicants replied on October 14, 2005, responding to the examiner's rejections and continuing the traverse of the election of species requirement.

The examiner mailed a Final Office action to applicants on January 10, 2006, maintaining all of the rejections for reasons of record.

Applicants filed an amendment after Final rejection on April 10, 2006 and a Notice of Appeal on June 15, 2006, and an Appeal Brief on September 12, 2006, concurrently with this petition.

## DISCUSSION

37 CFR 1.144 states as follows:

**1.144 Petition from requirement for restriction.**

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

The petition in this application was not filed until the Appeal Brief was filed which is after the Notice of Appeal and is, therefore, untimely.

## DECISION

The petition is **DISMISSED** as untimely.

**The application will be forwarded to the examiner for preparation of the Examiner's Answer or other appropriate action.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Bruce M. Kisliuk  
Director, Technology Center 1600